

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on May 11, 2004. Claims 26-53 are pending in the Application, Claims 26, 27, 29-32, 34-36, 38-41, 43-46, and 48-53 stand rejected, and Claims 28, 33, 37, 42, and 47 stand objected to as being dependent upon rejected base claims, but would be allowed if rewritten in independent form. The indication of allowable subject matter is noted with appreciation. Claims 26, 28-33, and 35-53 are amended by the present amendment.

In view of the allowable subject matter of Claim 28, Applicants have rewritten Claim 28 in independent form before further amending Claim 26. However, since Applicants believe that Claims 31, 40, and 45 recite patentable subject matter, Claims 33, 42, and 47 are maintained in dependent form at this time.

As to the objections to the amendment submitted on September 22, 2003, Applicants have submitted herein amendments to address these objections and respectfully request reconsideration of the same. The specification amendments to the list of figures have been submitted assuming that the previous amendment has been entered. The amendment replacing the paragraph beginning on page 16, line 14 has been corrected and resubmitted herein based on the indication that the previous amendment to the same paragraph was not entered.

Claim 50 was rejected under 35 U.S.C. §112, second paragraph. Applicants submit that the amendments to Claim 50 enclosed herein have overcome this rejection under 35 U.S.C. §112 and respectfully request its withdrawal.

Claims 26, 29, and 39 were rejected under 35 U.S.C. §102(b) as being anticipated by Susumu (Japanese Patent No. 9-226869, hereinafter “Susumu”). Applicants respectfully

submit that Claims 26 and 29 are not anticipated by Susumu because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference. In an anticipation rejection, MPEP § 2131 requires that the identical invention must be shown in as complete detail as is contained in the claim.

By virtue of the fact that the outstanding Office Action acknowledges that Susumu does not disclose the communication apertures of Claim 30<sup>1</sup> and the same communication apertures are recited in Claim 39, Applicants respectfully submit that cannot anticipate Claim 39. Withdrawal of the anticipation rejection of Claim 39 based on Susumu is respectfully requested.

As disclosed in the specification, the instant inventions are advantageous at least based on the fact that they address an existing pressing need to significantly reduce the thickness of conventional disc cases, while, at the same time, significantly improving their manufacturing process. For example, provision of mold apertures<sup>2</sup> in the holding plate and/or cover member enables the use of a two-part mold comprising upper and lower mold parts for the molding both parts. Conventionally, this process required a four-part mold.<sup>3</sup> In addition, by way of a non-limiting example, the thickness of a disc case of the instant invention is reduced by about 50% compared to the conventional cases.<sup>4</sup>

According to a feature of the invention as set forth in the presently amended Claim 26 a recording medium disc storage case is recited, comprising a holding plate having at least two mold apertures extending through a thickness of the holding plate and being located along upper and lower edges of the holding plate.

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<sup>1</sup> See, for example, outstanding Office Action, page 8, item 15.

<sup>2</sup> These mold apertures on a holding plate are illustrated as a non-limiting example by element 29, as for example, in FIGS. 12 and 14-16 of Applicants' specification.

<sup>3</sup> See, for example, specification, page 22, lines 11-22.

<sup>4</sup> *Id.*, page 26, lines 8-19.

As just explained, these apertures are the result of an advantageous manufacturing process that facilitates the use of a two-part mold comprising upper and lower mold parts for molding the holding plate.

Susumu describes an upper cover 4 having a projecting member 11 that engages with lower cover 3 having a clamp member. This prior art reference is silent as to the mold apertures as now recited in Claim 26. Therefore, Applicants respectfully submit that Claim 26 is not anticipated by Susumu. In addition, Claims 29 should be allowed, among other reasons, as depending either directly or indirectly from Claim 26, which is allowable as just explained. Therefore, Applicants respectfully request that the anticipation of Claims 26, 29, and 39 under 35 U.S.C. §102(b) based on Susumu be withdrawn.

In addition, Claim 29 recites subject matter similar to that recited in Claim 34. As such, if, as acknowledged by the outstanding Office Action, the references applied with respect to Claim 31 do not disclose the features of Claim 34, including Susumu, thus the need to cite Grobecker, the rejections of Claim 29 as being anticipated by Susumu already discussed above is improper. Applicants respectfully request further clarification.

Claims 26, 29 and 39 were rejected under 35 U.S.C. §102(b) as being anticipated by Kownacki (U.S. Patent No. 5,238,107, hereinafter “Kownacki”). Applicants respectfully submit that Claims 26 and 29 are not anticipated by Kownacki because each and every element as set forth in those claims is not found, either expressly or inherently described, in the cited reference.

Similarly to the previous rejection, by virtue of the fact that the outstanding Office Action acknowledges that Kownacki does not disclose the communication apertures of Claim 30<sup>5</sup> and the same apertures are recited in Claim 39, Applicants respectfully submit that

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<sup>5</sup> See, for example, outstanding Office Action, page 8, item 15.

Kownacki cannot anticipate Claim 39. Withdrawal of the anticipation rejection of Claim 39 based on Kownacki is respectfully requested.

Kownacki is also silent with respect to the mold apertures now recited in Claim 26.<sup>6</sup>

As such, Applicants respectfully submit that Claim 26 is not anticipated by Kownacki. In addition, Claims 29 should be allowed, among other reasons, as depending either directly or indirectly from Claim 26, which is allowable as just explained. Therefore, Applicants respectfully request that the anticipation of Claims 26, 29, and 39 under 35 U.S.C. §102(b) based on Kownacki be withdrawn and the claims passed to issuance.

In addition, Claim 29 recites subject matter similar to that recited in Claim 34. As such, if, as acknowledged by the outstanding Office Action, the references applied with respect to Claim 31 do not disclose the features of Claim 34, including Kownacki, thus the need to cite Grobecker, the rejections of Claim 29 as being anticipated by Kownacki already discussed above is improper. Applicants respectfully request further clarification.

Claim 27 was rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, as being unpatentable under 35 U.S.C. 103(a) as obvious over Susumu or Kownacki. Applicants respectfully submit that Claim 27 is neither anticipated nor made obvious by Susumu or Kownacki because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited references, individually or in any combination.

As explained in conjunction with the anticipation rejection of Claim 26, neither the Susumu nor Kownacki disclose the structural feature of the mold apertures resulting from the use of a two-port mold in the manufacturing process of the claimed disc cases. Claim 27 depends from Claim 26; therefore, it incorporates by reference all of the limitations thereof.

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<sup>6</sup> See, for example, Fig. 2 of Kownacki.

Thus, Claim 27 is not anticipated or made obvious by either Susumu or Kownacki, individually or in any combination.

In addition, Claim 27 is not anticipate or made obvious by neither Susumu nor Kownacki because neither reference discloses a storage case having a thickness greater than 6 mm.

The outstanding Office Action asserts that FIG. 15 of Susumu and FIG. 2 of Kownacki show a storage case having a thickness not greater than 6 mm. Applicants respectfully disagree.

Applicants respectfully remind the Examiner that "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue."<sup>7</sup> The above-referenced application discusses throughout its disclosure the criticality of the thickness of the disc case.<sup>8</sup> In fact, in the discussion of the prior art, the difficulty of making as thin as possible cases was discussed in view of the rigidity requirement for a disc case in order to minimize deformation and possible damage to disc stored in the case.<sup>9</sup>

In rejecting a claim, the USPTO must support its rejection by "substantial evidence" within the record,<sup>10</sup> and by "clear and particular" evidence<sup>11</sup> that every claimed feature is taught or disclosed in a reference. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record, that Susumu or Kownacki disclose a case

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<sup>7</sup> See, for example, MPEP §2125, citing In re Wright, 569 F.2d 1124,193 USPQ 332 (CCPA 1977).

<sup>8</sup> See, for example, specification, page 26, line 1 – page 27, line 8.

<sup>9</sup> Id., pages 1-4.

<sup>10</sup> In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

<sup>11</sup> In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.") (emphasis added).

having the recited thickness. Applicants respectfully request that such evidence be provided or the rejection of Claim 27 withdrawn.

The outstanding Office Action asserts that it would be obvious to make the thickness modification through routine experimentation. However, without clear, particular, and substantial evidence within the record to conclude that the thickness of the disc case has been recognized by those skill in the art as a result-effective variable, such a conclusion is at best an unsubstantiated conclusion based on conjecture.<sup>12</sup>

Finally, Applicants respectfully submit that the outstanding Office Action itself implicitly acknowledges that Susumu and Kownacki do not disclose the recited thickness of the disc case in the obviousness rejection of Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48, which will be discussed further below.<sup>13</sup> This is so because in that rejection, Susumu and Kownacki, the primary prior art references, were combined with other secondary references purportedly cited in support of the unsubstantiated conclusion that those secondary references teach and/or disclose disc case thicknesses and other recited critical dimensions. If that is so, at least the anticipation rejection of Claim 27 based on Susumu and Kownacki is improper.

Based at least on the foregoing remarks Applicants respectfully submit that Claim 27 is not anticipated or made obvious by Susumu or Kownacki. These cited prior art references are silent with respect to a case having a thickness of 6 mm. Therefore, Applicants respectfully request that the anticipation and obviousness rejections under 35 U.S.C. §§102(b) and 103(a) based on Susumu or Kownacki be withdrawn.

Claims 38-39 were rejected under 35 U.S.C. §102(b) as being anticipated by Nakasaji (U.S. Patent No. 5,896,985, hereinafter “Nakasaji”). Applicants respectfully submit that

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<sup>12</sup> “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP §2144.05, citing *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

<sup>13</sup> See, the outstanding Office Action, page 5, item 12.

Claims 38 and 39 are not anticipated by Nakasaji because each and every element as set forth in those claims is not found, either expressly or inherently described, in the cited reference.

Claim 38 recites a cover member that is larger than a holding plate. Claims 38 and 39 also recite that the cover member comprises a communication aperture extending through a thickness of the cover member and being configured to open a label holding claw.<sup>14</sup> The recited size of the cover member with respect to the holding plate is an importance feature designed to effectively prevent penetration of dust into the storage case as discussed by Applicants in the specification.<sup>15</sup>

No clear, particular, and substantial evidence within the record was provided to show that the recited size difference between the cover member and holding plate recited in Claim 38 is found in Nakasaji. Furthermore, Nakasaji is silent with respect to communication apertures. In Nakasaji, the label holding claw is affixed to the side of the cover C2, which is clearly illustrated without any communication apertures as recited in Claims 38 and 39. Therefore, Applicants respectfully request that the anticipation of Claims 38 and 39 under 35 U.S.C. §102(b) based on Nakasaji be withdrawn.

Claim 38 was rejected under 35 U.S.C. §102(b) as being anticipated by Davault (U.S. Patent No. 5,613,612, hereinafter “Davault”). Applicants respectfully submit that Claim 38 is not anticipated by Davault because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference.

As already explained, Claim 38 recites a cover member that is larger than a holding plate and a communication aperture extending through a thickness of the cover member configured to open a label holding claw. Similarly to the rejection based on Nakasaji, Applicants respectfully submit that no clear, particular, and substantial evidence within the record was provided to show that the recited size difference in Claim 38 is found in Davault.

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<sup>14</sup> As a non-limiting example, element 47 in FIGS. 19 and 27 of Applicants’ specification illustrates the recited communication aperture.

<sup>15</sup> See for example, specification, page 9, lines 2-5.

In addition, Davault is also silent with respect to a communication aperture in its cover element 12.

Applicants respectfully submit that Claim 38 is not anticipated by Davault. This cited prior art reference does not disclose a cover member that is larger than a holding plate or a cover having a communication aperture to open a label holding claw. Therefore, Applicants respectfully request that the anticipation of Claim 38 under 35 U.S.C. §102(b) based on Davault be withdrawn.

Claims 38-39 were rejected under 35 U.S.C. §102(b) as being anticipated by Taniyama (U.S. Patent No. 5,515,968, hereinafter “Taniyama”). Applicants respectfully submit that Claims 38 and 39 are not anticipated by Taniyama because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference.

As already explained, Claim 38 recites a cover member that is larger than a holding plate and Claims 38 and 39 recite a communication aperture in the cover member.

No clear, particular, and substantial evidence within the record was provided to show that the recited size difference of Claim 38 is found in Taniyama. Furthermore, as to Claims 38 and 39, Taniyama is silent with respect to any communication aperture in its cover member 34. Applicants respectfully submit that Claims 38 and 39 are not anticipated by Taniyama. Therefore, Applicants respectfully request that the anticipation of Claims 38 and 39 under 35 U.S.C. §102(b) based on Taniyama be withdrawn.

Claim 51 was rejected under 35 U.S.C. §102(b) as being anticipated by Mitsuhiro (Japanese Patent Publication No. 8-90610, hereinafter, “Mitsuhiro”). Applicants respectfully submit that Claim 51 is not anticipated by Mitsuhiro because each and every element as set forth in that claim is not found, either expressly or inherently described, in the cited reference.

Claim 51 recites a recording medium disc storage case, wherein, among other features, a holding plate comprises peripheral walls on opposite sides of a central indentation of the holding plate, each of the peripheral walls being formed with first and second step portions inwardly stepped there from, each of the second step portions being configured to receive a label holding claw. As a non-limiting example, element 27 in FIGS. 10 and 14 of Applicants' specification illustrate the now recited second step in the holding plate configured to receive a label holding claw.

As shown at least in FIG. 5 of Mitsuhiro, this prior art reference does not disclose a second step in the holding member 31 to receive a label holding claw. Thus, Applicants respectfully submit that Claim 51 is not anticipated by Mitsuhiro. As such, Applicants respectfully request that the anticipation of Claim 51 under 35 U.S.C. §102(b) based on Mitsuhiro be withdrawn.

Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Susumu or Kownacki in view of Official Notice or Mitsuhiro or Clemens (U.S. Patent No. 4,903,829, hereinafter “Clemens”).

Applicants respectfully submit that Susumu, Kownacki, Official Notice, Mitsuhiro, and Clemens, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48, directly or indirectly, recite critical dimensions for the disc case, i.e., in Claims 27 and 31, a case thickness of 6 mm; in Claim 40, a thickness of 4 mm between a rear surface of the holding plate and a top surface of the holding portion; and in Claim 45 a thickness of 5.2 mm.

The outstanding Office Action implicitly acknowledges that Susumu and Kownacki do not disclose the recited thicknesses and further asserts that it would be obvious in view of Official Notice, Mitsuhiro or Clemens to provide a container with the recited dimensions for storage and transportation and to reduce cost. Applicants respectfully disagree.

The taking of Official Notice is respectfully objected to because, in the present case, such an approach is contrary to patent examining procedures now in vigor since, as already explained hereinabove, there is a reasonable dispute as to whether or not there is substantial evidence on the record to substantiate a conclusion that the cited references disclose the recited critical dimensions of a disc case.<sup>16</sup> Mitsuhiro and Clemens are silent as to the dimensions claimed. Applicants reiterate the discussion above in connection with the rejection based on Kownacki and respectfully request that the Examiner provide clear and convincing evidence that Mitsuhiro and Clemens can support a finding of obviousness of the claimed disc case dimensions.

Absent substantial support for a finding that the cited references disclose or teach a disc case having the recited dimensions, Applicants respectfully submit that Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48 are not made obvious by Susumu or Kownacki in view of Official Notice, Mitsuhiro, or Clemens. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48 under 35 U.S.C. § 103(a).

Claims 31, 32, 34, 35, 40, 41, 43, 44, 45, 46, 48, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taniyama in view of Susumu or Kownacki and/or Mitsuhiro or Clemens.

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<sup>16</sup> “The notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute.’” MPEP §2144.03, citing (citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970) and *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Applicants respectfully submit that Taniyama, Kownacki, and Clemens, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claims 31, 32, 34, 35, 40, 41, 43, 44, 45, 46, 48, and 49. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claims 31, 32, 34, 35, 40, 41, 43, 44, 45, 46, 48, and 49 directly or indirectly recite the case dimensions as just discussed above in the obviousness rejection of Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48.

The outstanding Office Action asserts that several of the figures in the cited prior art references disclose disc cases having the recited dimensions. Applicants respectfully disagree and reiterate the above-noted discussion in conjunction with the rejection of Claim 27. Absent substantial support for a finding that the cited references disclose or teach a disc case having the recited dimensions, Applicants respectfully submit that Claims 31, 32, 34, 35, 40, 41, 43, 44, 45, 46, 48, and 49 are not made obvious over Taniyama in view of Susumu or Kownacki and/or Mitsuhiro or Clemens. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 31, 32, 34, 35, 40, 41, 43, 44, 45, 46, 48, and 49 under 35 U.S.C. § 103(a).

Claim 34 was rejected under 35 U.S.C. § 103(a) as being unpatentable over with the references applied above with respect to claim 31 further in view of Grobecker (U.S. Patent No. 4,805,770, hereinafter “Grobecker”).

Applicants respectfully submit that the references applied above with respect to Claim 31 and Grobecker, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claim 34. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claim 34 depends from Claim 31, and, as such, incorporates by dependency all of the limitations of Claim 31, including the recited thickness of the disc case, i.e., 6 mm.

Grobecker has been cited for suggesting a cover capable of pivoting relative to a holding member over 180 degrees, thus not remedying the above-noted deficiency of the references applied above with respect to Claim 31. Therefore, Applicants respectfully submit that Claim 34 is not made obvious by the combination of the references applied above with respect to claim 31 and Grobecker.

In addition, Applicants respectfully brings to the attention of the Examiner that Claim 34 does not recite the subject matter asserted in the rejection of that claim. Claim 34 recites: “[a] recording medium disc storage case of claim 31, wherein said cover member is larger than said holding plate so as to cover said holding plate completely and wherein a hinge member is located exclusively at opposite side portions of said cover member to pivotally hinge said cover member to said holding plate.”

Claim 29 recites subject matter similar to that recited in Claim 34. As such, if, as acknowledged by the outstanding Office Action, the references applied with respect to Claim 31 do not disclose the features of Claim 34, including the Susumu and Kownacki, thus the need to cite Grobecker, the rejections of Claim 29 as being anticipated by Susumu and Kownacki already discussed above is improper. Applicants respectfully request further clarification.

Claims 30, 35, and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied above with respect to claims 26, 31, or 41, further in view of Nakasaji (U.S. Patent No. 5,896,985, hereinafter “Nakasaji”) or Fraser et al. (U.S. Patent No. 5,788,068, hereinafter “Fraser”).

Applicants respectfully submit that the references applied above with respect to Claims 26, 31, or 41, Nakasaji, or Fraser, individually or in any combination thereof, do not

support a *prima facie* case of obviousness of the invention recited in Claims 30, 35, and 49.

This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claims 35 and 49 recite indirectly the thickness of the disc case by virtue of their dependency from either Claim 31 or Claim 45. Nakasuji was cited for teaching a plurality of communication apertures adjacent to the label holding claws. Fraser was cited for teaching communication apertures 11A on the cover member. As such, Nakasuji and Fraser do not remedy the above-noted deficiencies of the references applied with respect to Claims 31 or 45 as to the teaching or disclosure of the recited disc case thickness.

Claim 26 now recites the mold apertures. As already discussed, none of the references applied in the rejection of Claim 26 teach or disclose these features. Applicants respectfully submit that neither Nakasuji nor Fraser teach or disclose the same features. In addition, as to the assertion that Nakasuji teaches a plurality of communication apertures, Applicants respectfully disagree. The recesses in Nakasuji for accommodating the label holding claws are not communication apertures extending through a thickness of the cover member.

Thus, Applicants respectfully submit that the references applied with respect to Claims 26, 31, or 41, Nakasuji, and Fraser, individually or in any combination, do not make obvious the invention recited in Claims 30, 35, and 49. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 30, 35, and 49 under 35 U.S.C. § 103(a).

Claim 36 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the references applied above with respect to Claim 31 further in view of Mitsuhiko. Applicants respectfully submit that this rejection appears to be repeated in item 17 of the outstanding Office Action.

Applicants respectfully submit that the references applied above with respect to Claims 31, and Mitsuhiro, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claim 36. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claim 36 recites indirectly the thickness of the disc case by virtue of its dependency from Claim 31. As already explained, at least for the lack of substantial evidence on the record, the references cited in support of both rejections of Claim 31 do not make that claim obvious. Thus, Claim 36 should be allowed at least in view of its dependency from Claim 31. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claim 36 under 35 U.S.C. § 103(a).

In addition, in the rejections of Claim 31 already discussed above, Mitsuhiro was cited in combination with the other references. As such, it seems that, in the instant rejection of Claim 36, since Mitsuhiro is being combined with the references applied above with respect to Claim 31, Mitsuhiro appears to be being combined with itself.

Claims 50-51 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Susumu or Kownacki in view of Mitsuhiro.

Claim 50 recited a recording medium disc storage case, comprising, among other features, a holding plate formed with a central indentation at a central portion of each of upper and lower edges of the holding plate, the cover member also being formed with a central portion of a peripheral wall being adapted to fit the central indentation of the holding plate when the cover member is in its closed position, where the central portion of the cover member has a height equivalent to the thickness of the case.

Claim 51 recites a recording medium disc storage case, wherein, among other features, a holding plate comprises peripheral walls on opposite sides of a central indentation

of the holding plate, each of the peripheral walls being formed with first and second step portions inwardly stepped there from, each of the second step portions being configured to receive a label holding claw.

Applicants respectfully submit that Susumu, Kownacki, and Mitsuhiro, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in the presently amended independent Claims 50 and 51. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

As to Claim 50, Kownacki does not teach or disclosed any indentations. As to Susumu and Mitsuhiro, even if assuming *in arguendo* that central indentations are disclosed in their holding plates, these references do not disclose a cover member also being formed with a central portion of a peripheral wall being adapted to fit the central indentation of the holding plate when the cover member is in its closed position, and wherein the central portion of the cover member has a height equivalent to the thickness of the case. The walls of their covers are continuous from one side to the other without any central portion configured to fit the indentation in the holding plate and being of the thickness of the disc case as recited in Claim 50.

As to Claim 51, none of these three references disclose a holding plate with peripheral walls formed with first and second step portions, each of the second step portions being configured to receive a label holding claw.

Therefore, Susumu, Kownacki, and Mitsuhiro, individually or in any combination thereof, do not make obvious the invention recited in Claims 50 and 51. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 50 and 51 under 35 U.S.C. § 103(a).

Claims 50-51 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taniyama in view of Mitsuhiro.

As just explained in conjunction with the previous rejection, Mitsuhiro does not make obvious the invention recited in Claim 50 and 51. As far as Taniyama is concerned, it is unclear from the Office Action why this reference has been cited in this rejection of Claims 50, 51, and 53 and what the motivation to combine the references is.

As to Claim 50, even if assuming *in arguendo* that central indentations are disclosed in the holding plate of Taniyama, this reference does not disclose a cover member also being formed with a central portion of a peripheral wall being adapted to fit the central indentation of the holding plate when the cover member is in its closed position, and the central portion of the cover member has a height equivalent to the thickness of the case. The walls of the cover in Taniyama are continuous from one side to the other without any central portion configured to fit the indentation in the holding plate and being of the thickness of the disc case as recited.

As to Claim 51, Taniyama does not disclose a holding plate with peripheral walls formed with first and second step portions, each of the second step portions being configured to receive a label holding claw.

Claim 53 depends from Claim 51, as such, it incorporates by references all of the limitations thereof.

Applicants respectfully submit that Taniyama and JP 8-90610, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claims 50, 51, and 53. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claims 50, 51, and 53 under 35 U.S.C. § 103(a).

Claim 52 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied above with respect to Claim 51, further in view of Official Notice, or Mitsuhiro or Clemens.

Applicants respectfully submit that the references as applied above with respect to claim 51, Official Notice, Mitsuhiro, and Clemens, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claim 52. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claim 52 depends from Claim 51, and, as such, indirectly recites a recording medium disc storage case, wherein, among other features, a holding plate comprises peripheral walls on opposite sides of a central indentation of the holding plate, each of the peripheral walls being formed with first and second step portions inwardly stepped there from, each of the second step portions being configured to receive a label holding claw.

The application of Mitsuhiro to Claim 51 has already been discussed above. Clemens does not disclose the above-summarized features of Claim 51. Official Notice does neither. Therefore, at least in view of its dependency from Claim 51, Claim 52 patently distinguishes over the references as applied above with respect to claim 51, Official Notice, Mitsuhiro, and Clemens.

In addition, Claim 52 recites a thickness for the disc case. As already explained above in conjunction with the rejection of Claims 27, 31, 32, 40, 41, 44, 45, 46, and 48, no substantial evidence is found in the record that any of the cited references teach or disclose the claimed dimensions of the disc case.

Therefore, the references as applied above with respect to claim 51, JP 8-90610, or Clemens, individually or in any combination thereof, do not make obvious the invention

recited in Claim 52. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claim 52 under 35 U.S.C. § 103(a).

Claim 53 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied above with respect to Claim 51 further in view of Nakasuji or Fraser.

Applicants respectfully submit that the references as applied above with respect to claim 51, Nakasuji, or Fraser, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claim 53. This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claim 53 depends from Claim 51, and, as such, indirectly recites a recording medium disc storage case, wherein, among other features, a holding plate comprises peripheral walls on opposite sides of a central indentation of the holding plate, each of the peripheral walls being formed with first and second step portions inwardly stepped there from, each of the second step portions being configured to receive a label holding claw.

Nakasuji and Fraser do not disclose first and second step portions as recited in Claim 51. Therefore, the references as applied above with respect to claim 51, Nakasuji, and Fraser, individually or in any combination thereof, do not make obvious the invention recited in Claim 53. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claim 53 under 35 U.S.C. § 103(a).

Claim 52 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the references as applied above with respect to Claim 51 further in view of Susumu, Kownacki, Mitsuhiro and Clemens.

Applicants respectfully submit that the references as applied above with respect to Claim 51, Susumu or Kownacki, Mitsuhiro and Clemens, individually or in any combination thereof, do not support a *prima facie* case of obviousness of the invention recited in Claim 52.

This is so because, even when combined, these prior art references do not teach or suggest all the claim limitations recited therein.

Claim 52 depends from Claim 51, and, as such, indirectly recites a recording medium disc storage case, wherein, among other features, a holding plate comprises peripheral walls on opposite sides of a central indentation of the holding plate, each of the peripheral walls being formed with first and second step portions inwardly stepped there from, each of the second step portions being configured to receive a label holding claw.

As already explained, the references as applied above with respect to Claim 51, do not teach or disclose the new features recited in Claim 51. In addition, Applicants respectfully submit that Susumu, Kownacki, Mitsuhiro, and Clemens do not teach or disclose the same features. Therefore, the references as applied above with respect to Claim 51, Susumu or Kownacki, and/or Mitsuhiro or Clemens, individually or in any combination thereof, do not make obvious the invention recited in Claim 52.

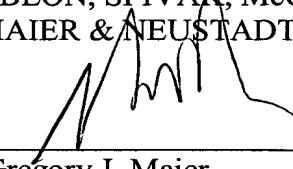
In addition, Claim 52 recites a thickness for the disc case. As already discussed, no substantial evidence has been provided in the outstanding Office Action to support a finding that any of the cited prior art references teach or disclose the recited thickness in Claim 52. For the foregoing remarks, Applicants respectfully request that the Examiner withdraw the rejection of Claim 52 under 35 U.S.C. § 103(a).

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 26-53 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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